



Department of Energy

Washington, DC 20585

Date: August 28, 2006

Re: Surveillance Responsibility, Internal Patent Instruction for Patent Counsel

Under the normal procedures for contract administration, the Field IP Counsel Office (or HQ) organizationally assigned to assist the procuring activity which awarded the contract¹ will administer the intellectual property provisions for that contract.

The general rule is that contracts should not be assigned by one Field IP Counsel Office to another. Exceptions are permitted such as where (1) there is a long-standing arrangement between Field IP Counsels; (2) DOE Program cognizance is located at an activity served by the transferee IP Counsel Office; (3) there is a transfer of the responsibility for contract administration to a different procuring activity (ordinarily the IP administration will be transferred to the IP Counsel Office supporting the transferee procuring activity); or (4) other factors indicate the appropriateness for another Field IP Counsel Office to have the responsibility for administering the IP for the contract.

Required Field IP Counsel Office duties include:

1. In accordance with all Patent Rights clauses required by the FAR and/or DEAR such as FAR 52.227-12)
 - a. Receipt of invention disclosures;
 - b. Monitoring of invention disclosures including election of title and filing of patent applications by the contractor, and examination of any books, records or documents of the contractor relating to subject inventions to ensure contractor compliance;
 - c. Ensuring contractor action to protect the government's interests which includes reviewing a final report by the contractor listing all subject inventions and all subcontracts at any tier containing a patent rights clause if present.
 - d. Issuing final close out patent clearance, ensuring that all of the information required under Patent Certification Form OMB No. 1902-0121 is complete.
2. In accordance with Patent Rights clauses with those not qualifying under 35 U.S.C. 200 *et seq* or where the Government is retaining title to subject inventions such as 48 CFR 952.227-13, grant or deny approval for release of publication of certain inventions in order to protect the interests of DOE or the contractor;

¹ The term contract is used herein generically and includes contract, grant, cooperative agreement or other arrangement including subawards at any tier.



3. In accordance with the Rights in Data-Technology Transfer clause 48 CFR 970.5227-2 included in Management and Operating contracts having technology transfer as a mission, review and approval of any contractor's request to assert copyright.

A handwritten signature in black ink, appearing to read 'P. A. Gottlieb', is positioned above the printed name.

Paul A. Gottlieb

Assistant General Counsel for Technology
Transfer and Intellectual Property